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Supreme Court, U.S.
FILED
APR 21 1999
CLERK

No. 98-1393

In The

Supreme Court of the United States

October Term, 1998

STUN-TECH, INC.,

Petitioner,

vs.

R.A.C.C. INDUSTRIES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

COUNTER-STATEMENT OF THE CASE

Respondent generally agrees with the Petitioner's Statement of the Case. It disagrees, however, with the summary of the patent specifications set forth at page 3 of the Petition and refers the Court to the relevant claims of the patent itself, set forth verbatim at pages 4-5 of the Petition. Respondent further would point out that the last two paragraphs of the Statement of the Case, referring to Petitioner's High Security Transport Belt ("HSTB"), is somewhat misleading and inconsistent with the evidence presented to the District Court. While there was testimony from Petitioner's president that the HSTB is used primarily for transport of prisoners and not for in-court situations, there were also documents introduced into evidence which established that the HSTB is in fact used from time to time in court, with the belt concealed underneath a prisoner's clothing. Furthermore, there was an in-court demonstration of the HSTB which conclusively established that the device was capable of being "adapted for concealment beneath garments", as described in Claim 1 of the Patent.

REASONS FOR DENYING THE WRIT

Even if the question presented for review were answered in the affirmative, there would be no basis for reversal of the decision of the United States Circuit Court for the Federal Circuit. That decision was based, as was

that of the District Court, on the structural limitations of the patent claims found to have been infringed.

The Petition points to no error in the decisions below in interpreting the claims of the '885 Patent. It points to no problems experienced by District Courts in interpreting apparatus claims containing functional language. Nor does Petitioner advance any compelling reason why this Court is being called upon to define a new type of claim which has not been provided for by statute.

The Petition does not point to any inequity which would be worked upon the infringer by denial of the Petition. Petitioner has admitted that one of its two models, namely, the Minimum Security Belt ("MSB"), is an infringement of Claims 1 and 4 of the '885 Patent, and it has acknowledged that the other model, the HSTB, is also capable of infringing.

The Petition is founded upon the factually erroneous premise that the claims of the patent in suit are apparatus claims which were allowed by the Patent and Trademark Office only "when the functional language . . . was added to the claims and it was urged that the patented device could be worn under clothing where it would be effectively concealed". Petition, at p. 8. This conclusion is completely contrary to the findings of fact below. As the Federal Circuit noted,

> This prosecution history shows that RACC was unable to distinguish its invention from the prior art based solely on intended use. Only by adding the structural limitation requiring torso

> mounting did RACC successfully overcome the prior art.

App. 8 to the Petition.

The District Court found that the accused MSB and HSTB models were adapted for concealment. The Petitioner did not challenge the findings that its MSB infringed Claims 1 and 4. Petitioner's counsel also conceded at oral argument before the Federal Circuit, as he did in Petitioner's main brief in that Court, that the HSTB is used in courtroom situations wherein it is adapted, as well as intended, to be concealed. The District Court's analysis was rigorous and scrupulously adhered to a structural, element-by-element application of the claims against the infringing belts. Petitioner cannot point to any faulty reasoning in the opinions below.

Petitioner has had its day(s) in court, but now wants this Honorable Court to devise a completely new form of claim which it admits is not provided for by statute. Such a new, hybrid form of claim would not relieve Petitioner from the fact that it has infringed the new and non-obvious structural limitations of the claims in suit, as specifically found by the District Court below. For that reason alone, the Petition should be denied.

Respectfully submitted,

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